

set forth the exact residence/mailing addresses of the inventors. Applicants herewith submit a supplemental Declaration which is newly executed and in which the exact residence/mailing addresses of the inventors are specified.

(3) The Examiner criticized that the assignee's statement under 37 CFR §3.73(b) and the the assignee's Declaration were not executed by the same authorized representatives of the assignee. It is respectfully submitted that the assignee, BASF Aktiengesellschaft, is a corporation which has more than two individuals who are authorized to execute the respective papers on behalf of assignee. The signatures of Dres. Köster and Stark are as binding for the assignee as the signatures of Dres. Wicke and Heistracher. The fact that the respective papers were executed by different authorized representatives is, therefore, not deemed to have an effect on the validity of the statement or the Declaration.

(4) The Examiner also criticized that the Declaration failed to designate the inventors as "joint" inventors asserting that 37 CFR §1.63(a) requires such a designation. It is respectfully submitted that neither Rule 63(a) nor any other part of Rule 63 or Rule 175 imposes a requirement to specify the inventors involved in the invention as "joint" inventors.

(5) The Examiner asserted that the Declaration was defective for failing to state that all errors being corrected in the reissue application up to the time of the filing of the declaration arose without any deceptive intention on the part of the applicant. It is respectfully urged that a statement to that effect was made on page 2 of the Declaration. A corresponding statement is found on page 2 of the supplemental oath enclosed herewith.

The Examiner also pointed out that the reissue oath failed to claim the relationship between application Serial No. 08/843,323 filed on April 14, 1997, *PCT/US 98/05615* filed on March 23, 1998, and US 6,255,309. It is respectfully submitted that the relationship between *PCT/US 98/05615* filed on March 23, 1998, and US 6,255,309 was correctly claimed in the declaration which was filed by applicants when application Serial No. 09/272,916, which issued as US 6,255,309, was filed with the U.S. PTO on July 22, 1999. As stated in that declaration, application Serial No. 09/272,916 claimed priority under

Section 119(a) of *PCT/US 98/05615* filed on March 23, 1998<sup>1)</sup>. As pointed out by applicants in their submission accompanying this reissue application, the error which is sought to be corrected by the reissue application is applicants' inadvertent omission to perfect the claim to priority of *PCT/US 98/05615* by filing a certified copy of *PCT/US 98/05615*. The respective certified copy has meanwhile been submitted<sup>2)</sup> and should, therefore, be of record.

Accordingly, the correction sought to be entered by the Office is the entry and consideration of the certified copy of *PCT/US 98/05615*, filed on March 23, 1998, and acknowledgement of the perfected claim to priority of that PCT/US application on the face of the reissued patent.

For clarification purposes it is further respectfully submitted that the current reissue application is in no direct relation to U.S. application Serial No. 08/843,323 which was filed on April 14, 1997. *PCT/US 98/05615* filed on March 23, 1998, was originally related to U.S. application Serial No. 08/843,323 through a claim to priority under Section 119 which was made in the PCT/US application<sup>3)</sup>. The requisite claim to priority was, however, not reiterated when application Serial No. 09/272,916 was filed<sup>4)</sup>.

The Examiner stated that the benefit of the priority of *PCT/US 98/05615*, filed on March 23, 1998, could not be granted in this application for lack of continuity. Favorable reconsideration of the Examiner's position is respectfully solicited in light of the provisions of 35 U.S.C. §119(a). Accordingly, a U.S. application may claim the benefit of the filing date of an application which is filed in a WTO member country as long as the U.S. application is filed within twelve months from the date on which the application in the WTO member country was filed. *PCT/US 98/05615* filed in a WTO member country on March 23, 1998, and U.S. application Serial No. 09/272,916 was filed on March 19, 1999, which is within the twelve month period

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- 1) Cf. also applicants' submission which was filed along with this reissue application.
  - 2) The respective copy was submitted on January 27, 2003, along with a petition. Although the petition was subsequently dismissed, the certified copy necessary to perfect applicants' claim to priority under Section 119 is deemed to be of record. A copy of the Certified Copy is herewith enclosed for the Examiner's convenience.
  - 3) Cf. the attached copy of the Certified Copy of *PCT/US 98/05615*.
  - 4) Cf. the declaration filed on July 22, 1999, in application Serial No. 09/272,916, which issued as US 6,255,309.

referenced in Section 119(a). Also, since applicants' claim to priority is neither under Section 119(e) nor under Section 120, an amendment of the specification to recite the relevant data as required by the Examiner is not deemed to be appropriate in this case.

The Examiner provisionally rejected Claim 1 to 6 under the judicially created doctrine of obviousness-type double patenting as being unpatentable in light of Claims 1 to 5 of co-pending application Serial No. 09/840,488. Favorable reconsideration of the Examiner's position and withdrawal of the respective rejection is respectfully solicited in light of the Terminal Disclaimer concerning US 6,255,309 which was filed by applicants in application Serial No. 09/840,488 on January 27, 2003<sup>5)</sup>. The respective Terminal Disclaimer already ensures that the term on a patent granted on this application and will not extend beyond the term of a patent granted on application Serial No. 09/840,488, and that a patent granted on this application shall only be enforceable for and during such a period as the legal title to such patent is the same as the legal title to a patent granted on application Serial No. 09/840,488.

The Examiner further rejected Claims 1 to 6 under the judicially created doctrine of obviousness-type double patenting as being unpatentable in light of Claims 1, 11 and 12 of US 5,593,996. Favorable reconsideration of the Examiner's position and withdrawal of the respective rejection is respectfully solicited. US 5,593,996 and its European equivalent EP 550 113 were applied under Section 103(a) in the earlier proceedings of application Serial No. 09/272,916 in an Office action dated December 08, 1999. Applicants addressed the respective rejection in their reply dated April 26, 2000, and the rejection was subsequently withdrawn by the Examiner. The determination of obviousness-type double patenting essentially parallels a determination of unobviousness under 35 U.S.C. §103, with the exception that the patent disclosure is not applicable as "prior art"<sup>6)</sup>. The Examiner's reasons for withdrawing the earlier rejection under Section 103(a) should, therefore, also obviate the rejection under the

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5) A copy of the respective Terminal Disclaimer is herewith enclosed for the Examiner's convenience.

6) Cf. In re Braat, 937 F.2d 589, 594, 19 USPQ2d 1289, 1293 (CAFC 1991); In re Vogel, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970).

judicially created doctrine of obviousness-type double patenting. Favorable action is respectfully solicited.

The Examiner noted that neither the specification nor the claims of application Serial No. 08/843,323 were suitable to support the subject matter disclosed and claimed in the present application. It is respectfully urged that the respective support is clearly provided by the disclosure of *PCT/US 98/05615*<sup>7)</sup>. Favorable action is respectfully solicited.

The Examiner asked that applicants provide information on any other possibly related application. Accordingly, applicants herewith enclose a supplemental Information Disclosure Statement which lists the art cited in co-pending divisional application Serial No. 09/840,488. Entry and consideration of the attached is respectfully solicited.

For completeness sake, it is also respectfully submitted that applicants will surrender the original ribboned copy of the patent as soon as all other issues in this application have been resolved.

In the event that the Examiner is of the opinion that further explanations or clarifications are necessary or desirable in this matter, applicants would greatly appreciate it if the Examiner would grant their representative the opportunity address such matters in a personal interview to facilitate the proceedings.

REQUEST FOR EXTENSION OF TIME:

It is respectfully requested that a three month extension of time be granted in this case. The Commissioner is hereby authorized to charge the respective \$10200.00 fee to Deposit Account No. 11.0345.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit

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7) Cf., for example, pages 3 and 4 of the enclosed copy of the Certified Copy of *PCT/US 98/05615*.

Serial No. 10/643,707

PEES et al.

ACY33350-02

Account No. 11.0345. Please credit any excess fees to such deposit account.

Respectfully submitted,

KEIL & WEINKAUF



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Encl.: Supplemental Statement under 37 CFR §3.73(b)  
Supplemental Reissue Declaration  
Copy of the Certified Copy of **PCT/US 98/05615**  
Terminal Disclaimer filed in application Serial No. 09/840,488  
Supplemental Information Disclosure Statement

HBK/BAS